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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,016	11/12/2003	Michael D. Potter	2420/123	6205
7590	05/20/2005			EXAMINER TAMAI, KARL I
Nixon Peabody LLP Clinton Square P.O. Box 31051 Rochester, NY 14603-1051			ART UNIT 2834	PAPER NUMBER

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No.	Applicant(s)
	10/706,016	POTTER, MICHAEL D.
	Examiner	Art Unit
	Tamai IE Karl	2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 November 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/12/2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the additional stored static charge must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: member with an additional stored static charge.
4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

5. Claims 1-33 are objected to because of the following informalities: Claims 1-33 are objected to because they are vague and indefinite. The claims are vague and indefinite because they recite an additional stored static charge when a first stored static charge has not been claimed. For the purpose of advancing prosecution on the merits the examiner assumes the member has a first and an additional stored charge. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 2, 4, 5, 10, 12, 14, 15, 17, 18, 23, 25, 27, 28, 31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jewett et al. (Jewett)(US 3,405,334) and Crites (US 4,288,735). Jewett teaches an electrostatic generator with fixed electrodes on opposite sides of the moving electrode. Jewett teaches a resilient member 148 connected to the electrodes indirectly through the housing and the moving member. Jewett teaches a single dielectric layer on the electrodes. Jewett teaches the moving electrodes can be a single electrode (fig 12) or may have an additional electrode (fig 13). Jewett teaches every aspect of the invention except the moving electrode being a static stored electrical charge or the charge being monopole. Crites teaches the moving member having a stored electrical charge member 61 with a monopole structure. It would have been obvious to a person of ordinary skill in the art at the time of the invention to construct the generator of Jewett with a first and additional stored charged electret because Crites to establish a variable capacitance and generate electrical power, and because the moving electret would not require power supply to the moving member.

8. Claims 3, 16, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jewett et al. (Jewett)(US 3,405,334) and Crites (US 4,288,735). Jewett and Crites teaches every aspect of the invention except the additional stored static charge being at least 1×10^{10} charges/cm². It would have been obvious to a person of ordinary skill in the art at the time of the invention to construct the generator of Jewett and Crites with the additional stored static charge being 1×10^{10} charges/cm² to optimize the current generated, and because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (see *In re Aller*, 105 USPQ 233).

9. Claims 11, 13, 24, 26, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jewett et al. (Jewett)(US 3,405,334) and Crites (US 4,288,735), in further view of Spence (US 3,786,495). Jewett and Crites teaches every aspect of the invention except the member having two or more dielectric layers with the charge stored therebetween or the specific material (as set forth in claim 13). Spence teaches an electrostatic charge being stored being insulating layers 14 and 16, of silicon oxide and silicon nitride. It would have been obvious to a person of ordinary skill in the ad to construct the electrostatic generator of Jewett and Crites with the insulating layers of Spence to create a large charge density.

10. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jewett et al. (Jewett)(US 3,405,334) and Crites (US 4,288,735), in further view of Wahlstrom

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(US 4126822). Jewett and Crites teach every aspect of the invention except storing the output potential. Wahlstrom teaches electrostatic generators are used to store/recharge watch batteries. It would have been obvious to a person of ordinary skill in the art to construct the electrostatic generator of Jewett and Crites with the battery of Wahlstrom to prolong the life a device with a battery.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 7-9 and 20-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 and 11 of U.S. Patent No. 6750590. Although the conflicting claims are not identical, they are not patentably distinct from each other because the inclusion on an additional stored static charge members is obvious to a person of ordinary skill in the art to increase the generating capacity of the device. The additionally limitations of claim 8, 9, 21 and 22 are shown by Jewett and Crites.

Allowable Subject Matter

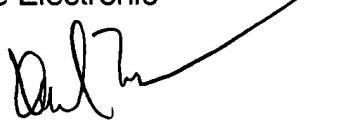
13. Claims 6 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl I.E. Tamai whose telephone number is (571) 272 - 2036.

The examiner can be normally contacted on Monday through Friday from 8:00 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg, can be reached at (571) 272 - 2044. The facsimile number for the Group is (703) 872 - 9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karl I Tamai
PRIMARY PATENT EXAMINER
May 15, 2005


KARL TAMAI
PRIMARY EXAMINER